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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,429	09/08/2003	Joseph Schlessinger	038602-1306	3634
22428	7590	01/27/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			STEADMAN, DAVID J	
			ART UNIT	PAPER NUMBER
			1656	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/049,429

**Applicant(s)**

SCHLESSINGER ET AL.

**Examiner**

David J. Steadman

**Art Unit**

1656

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires 3 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on 11 January 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a)  They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b)  They raise the issue of new matter (see NOTE below);  
 (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): see attachment.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13.  Other: \_\_\_\_\_.

  
 David J. Steadman, Ph.D.  
 Primary Examiner  
 Art Unit: 1656

**ADVISORY ACTION**

[1] Applicant's amendment to the claims, filed on 1/11/2006, is acknowledged and has been entered into the application. This listing of the claims replaces all prior versions and listings of the claims.

[2] Applicant's amendment to the specification, filed on 1/11/2006, is acknowledged and has been entered into the application.

[3] The request for reconsideration of the claims is acknowledged. While the amendment overcomes the objection to the specification, the objections to the claims, the rejection of claim 1 under 35 U.S.C. 112, second paragraph, and the new matter and written description rejections of claim 1 under 35 U.S.C. 112, first paragraph, the amendment fails to place the claims in a condition for allowance for the reasons stated below.

[4] The rejection of claim 3 under 35 U.S.C. 112, second paragraph, is maintained for the reasons of record and the reasons stated below.

**RESPONSE TO ARGUMENT:** Applicant argues the rejection is overcome by amendment.

Applicants' argument is not found persuasive. Claim 3 is confusing because, while a protein-protein complex of FGFR1 D2-D3 complexed with FGF-1 may have the atomic structural coordinates of Table 2, a crystal does not have "atomic structural coordinates." As previously noted, a crystal is typically defined by vectors  $a$ ,  $b$ ,  $c$ , and angles  $\alpha$ ,  $\beta$ ,  $\gamma$  between them.

[5] The written description rejection of claim 3 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and the reasons stated below.

RESPONSE TO ARGUMENT: Applicant argues the rejection is improper because the examiner refers to the specification rather than the recited limitations of the claim. Applicant argues the crystal of claim 3 is a “particular species” that is explicitly claimed and supported by Table 2.

Applicants' argument is not found persuasive. As noted above, while the structure of a protein-protein complex may be described by atomic structural coordinates, a protein crystal is not. As acknowledged by the specification and the prior art, a protein crystal is described by vectors  $a$ ,  $b$ ,  $c$ , and angles  $\alpha$ ,  $\beta$ ,  $\gamma$  between them. The genus of claimed crystals encompasses widely variant species, particularly in view of the disclosure of the specification, which states, “the structural coordinates set forth in Tables 1-4 and 6 are not limited to the values defined therein” (specification at p. 10, lines 23-24). While applicant argues the examiner is referring to the disclosure and not the recited limitations, applicant is reminded that, in accordance with MPEP 2111, during examination, the claims are given their broadest reasonable interpretation in light of the specification. As such, the claim encompasses a crystal of any protein-protein complex, particularly as there are no recited structural features of the FGFR1 D2-D3 polypeptide, the FGF-1 polypeptide, or the crystal itself. In this case, the specification discloses only a single species of crystals encompassed by the genus of claim 3, i.e., the crystal of claim 1. Other than this single disclosed species, the specification fails to describe other crystals of FGFR1 D2-D3 complexed with FGF-1 having the atomic

coordinates of Table 2. While MPEP § 2163 acknowledges that in certain situations "one species adequately supports a genus", it also acknowledges that "[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species cannot be achieved by disclosing only one species within the genus." In this case, the claimed crystal encompasses widely variant species and the single disclosed crystal that falls within the genus fails to represent the variation among the species within the genus. At least for these reasons and the reasons of record, the specification fails to adequately describe the crystal of claim 3.

[6] The scope of enablement rejection of claim 3 under 35 U.S.C. 112, first paragraph, is maintained for the reasons of record and the reasons stated below.

RESPONSE TO ARGUMENT: Applicant argues the rejection is overcome by amendment. However, this is not found persuasive and the claim remains rejected for the reasons of record.

[7] Status of the claims:

Claims 1 and 3 are pending.

Claim 1 is in condition for allowance.

Claim 3 is rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Thurs, 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1656

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Steadman, Ph.D.  
Primary Examiner  
Art Unit 1656